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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,819	06/30/2000	Russell M. Krapf	K35A0627	2409

26332 7590 08/11/2004

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EXAMINER

SHELTON, BRIAN K

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,819

Applicant(s)

KRAPF, RUSSELL M.

Examiner

Brian Shelton

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4,6,7</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to the Application filed 30 June 2000.
2. The Application has been examined. **Original claims 1-23** are pending. The rejections cited are as stated below:

Claim Objections

3. **Claim 8** is objected to because of the following informalities:

In **claim 8** at line 2, "the pre-recorded conditional access video content" should be changed to --pre-recorded conditional access video content-- because no corresponding element is disclosed in parent claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-4, 6, 9, 12-14, 17, 19 and 23** are rejected under 35 U.S.C. 102(b) as being anticipated by Hendricks et al. (Hendricks), U.S. Patent No. 5,798,785 (provided by Applicant in the IDS dated 22 July 2002).

Regarding **claims 1 and 12**, Hendricks discloses a video system and corresponding method of operating a video system that receives video data that includes a plurality of premium contents (Fig. 3), comprising:

- a) an input port (Fig. 4, Input of Set Top Terminal **220**) configured to receive video data (col. 9, lines 35-48), the video data including a plurality of premium contents (col. 11, lines 24-26; see Fig. 8);
- b) an output port configured to couple to a video display (Fig. 3, Television **222**) for display video data selected by a viewer (col. 9, lines 35-48);
- c) a preference engine coupled to the input port and configured to track viewer selections of the video data and to create a viewer profile representing viewing preferences of the viewer (col. 29, lines 7-44; col. 33, line 66 – col. 34, line 19); and
- d) a promotion module coupled to the preference engine and the output port, the promotion module responsive to the viewer profile to select at least one preferred promotion content from the plurality of premium contents, to cause the selected at least one preferred promotion content to be stored, and to cause the selected at least one preferred promotion content to be displayed to entice the viewer to watch a premium content associated with the selected at least one preferred promotion content (col. 19, lines 18-27; col. 13, lines 20-33; col. 30, lines 4-50 and col. 32, lines 64-67).

As for **claim 2**, Hendricks discloses a set-top box (Figs. 3 and 4, Set Top Terminal 220) coupled to the input port and configured to receive video data (col. 9, lines 35-48; see col. 13, lines 34-39).

As for **claims 3 and 17**, Hendricks discloses the plurality of premium contents includes a plurality of conditional access video contents (col. 20, line 57 – col. 21, line 21 describing event data including pay-per-view (i.e., “conditional access”) events; see col. 21, lines 35-36 and Fig. 14).

As for **claims 4 and 18**, Hendricks discloses the conditional access video content is provided through a pay-per-view service (col. 20, line 57 – col. 21, line 21 describing event data including pay-per-view events; see col. 21, lines 35-36 and Fig. 14).

As for **claims 6 and 23**, Hendricks discloses the promotion module causes display of the selected at least one preferred promotion content as a content selected from a group consisting of a video clip, a trailer (col. 19, lines 18-27), a program title, and a program description (col. 13, lines 20-35; see Fig. 14).

As for **claim 9**, Hendricks discloses the condition for access is payment of a fee (col. 20, line 57 – col. 21, line 21 describing event data including pay-per-

view events; see col. 21, lines 35-36 and Fig. 14 showing \$1.95 fee for viewing. Pay per view programming inherently discloses payment of a fee as a condition for access to the content).

As for **claim 13**, Hendricks discloses displaying the selected promotion content occurs upon determining that the viewer is watching video data displayed on a video display (col. 19, lines 18-27; col. 13, lines 20-35, describing display of promos in interactive display).

As for **claim 14**, Hendricks discloses displaying the at least one of the premium content corresponding to the selected promotion content upon the viewer selecting the displayed selected promotion content (col. 19, lines 18-27 and lines 58-60; col. 13, lines 20-35).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 5 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al. (Hendricks) in view of Garfinkle, U.S. Patent No. 5,530,754

Regarding **claims 5 and 19**, although Hendricks discloses output to a video recorder (col. 9, lines 38-48 and col. 14, lines 7-20), Hendricks fails to specifically disclose circuitry configured to provide for the functionality of a personal video recorder further providing for pre-recording conditional access video content and promotion content, as claimed.

However, Garfinkle, in an analogous art, teaches a personal video recorder for pre-recording video data (i.e. downloading video data and storing prior to display) (Fig. 1, Product Store **24** and Catalog Store **22**), with circuitry further providing for recording of conditional access content (e.g., Video on demand) (Fig. 5, els. **72, 74, 75, 76, 78, 80, 82, 84, 86, and 88**; see col. 4, line 59 – col. 5, line 14) and promotion content (Fig. 5, els. **64, 66, 68**; see col. 4, lines 35-58, disclosing catalog data including trailers (i.e., promotional content)) for the benefit of providing a user with an interactive display utilizing locally stored data to assist in identifying, previewing and ordering a video product and allowing a user to start viewing the product at the time it is ordered (see col. 1, lines 58-67).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the video recorder of Hendricks to incorporate the functionality of a personal video recorder providing for pre-recording the conditional access video content and preferred promotion content, as taught by Garfinkle, for the benefit of providing a user with an interactive display utilizing locally stored data to assist in identifying, previewing and

ordering a video product and allowing a user to start viewing the product at the time it is ordered.

8. **Claims 7-8 and 20-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Tsukamoto et al. (Tsukamoto), U.S. Patent No. 5,796,828.

Regarding **claims 7-8 and 20-21**, Hendricks fails to disclose the claimed first module configure to scramble conditional access video and second scrambler module configured to de-scramble the pre-recorded conditional access video content

However, Tsukamoto in an analogous art, teaches a first scrambler module (Fig. 2, Encipher **22**) and a second scrambler module (Fig. 2, Decipher **25**), where the first scrambler module is configured to scramble conditional access video content prior to pre-recording (col. 8, line 41 – col. 9, line18) and the second scrambler module is configured to de-scramble the pre-recorded conditional access content upon fulfilling a condition for access (col. 9, lines 26-51) for the benefit of preventing the reproduction of transmitted data by a user without adequate payment for each reproduction (col. 1, lines 35-37).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the video system of Hendricks to incorporate a first module configured to scramble the conditional access video

content prior to pre-recording it and a second scrambler module configured to de-scramble the pre-recorded conditional access video content upon fulfilling a condition for access, as taught by Tsukamoto, for the benefit of preventing the reproduction of transmitted data by a user without adequate payment for each reproduction.

The limitation of **claim 22** is encompassed by the teachings of Hendricks in view of Tsukamoto, as discussed above relative to claim 21. Specifically, Hendricks discloses the condition for access is payment of a fee (col. 20, line 57 – col. 21, line 21 describing event data including pay-per-view events; see col. 21, lines 35-36 and Fig. 14, showing \$1.95 fee for viewing. Pay per view programming inherently discloses payment of a fee as a condition for access to the content).

9. **Claims 10 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Williams et al. (Williams), U.S. Patent No. 5,977,964.

As for **claims 10 and 15**, although Hendricks discloses creating a plurality of viewer profiles (col. 38, lines 7-15) Hendricks fails to specifically disclose the promotion module configured to store a plurality of sets of data, each set of data including a viewer profile, as claimed.

However, Williams, in an analogous art, teaches a plurality of user profiles where each profile represents preferences of the user and includes content selected according to the preferences of the user (e.g., custom advertisements) (col. 5, line 52 – col. 6, line 49) for the benefit of individually configuring a system in accordance with the preferences of each of a plurality of user's to enhance each users enjoyment of operating the system (see col. 3, lines 20-27).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the promotion module of Hendricks to incorporate the plurality of viewer profiles each representing viewing preferences of a viewer and including preferred promotion contents selected in accordance with the viewing preferences of the viewer, as taught by Williams, for the benefit of individually configuring a system in accordance with the preferences of each of a plurality of users to enhance each user's enjoyment of the system in a method of operating a video system.

10. **Claims 11 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks in view of Williams et al. (Williams), U.S. Patent No. 5,977,964, as applied to claims 10 and 15 above, further in view of Eldering et al. (Eldering), U.S. Patent No. 6,684,194.

As for **claims 11 and 16**, the teachings of Hendricks in view of Williams are relied upon, as discussed above relative to claims 10 and 15. Although

Williams suggest selecting a user profile according to observed behavior (col. 9, lines 25-64), Williams fails to specifically disclose selecting a viewer profile upon determining which viewer is likely to be watching at a given day and time, as claimed.

However, Eldering, in an analogous art, teaches selecting a viewer profile from a plurality of viewer profiles based upon determining characteristics specific to a viewer, including the time of day a specific subscriber views programming (col. 2, lines 49-60 and col. 3, lines 46-61) for the benefit of passively identifying a particular viewer by correlating subscriber actions (e.g., when the system is used) with stored profile data (see col. 1, line 64 – col. 2, line 2).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the viewer profiles of Hendricks in view of Williams to incorporate determining which viewer is likely to be watching at a given data and at a given time, as taught by Eldering, for the benefit of passively identifying a particular viewer by correlating subscriber actions, such as when the system is used, with stored profile data in a video system.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Billock et al. (Billock), U.S. Patent No. 6,314,575, discloses an interactive interface for facilitating the selection of video-on-demand programming which provides the user with still images, full motion previews, and textual descriptions of the available programs (abstract) wherein the programming list made available to a viewer is limited by programming classification data (col. 13, lines 48-62) and listings of video-on-demand programming is further selected according to a category (e.g., genre) assignment (col. 7, lines 13-22; see also col. 9, line 59 – col. 10, line 29).

Lumley et al (Lumley), U.S. Patent No. 6,588,013, discloses a promotional video system including an electronic programming guide wherein promotional material is selected according to a promotional selection algorithm and presented in a promotional display screen (Fig. 2; col. 6, lines 8-56; see col. 5, lines 19-35).

Feng, U.S. Patent No. 6,483,523, discloses a browser interface for selecting programming from a VOD server wherein the browser presents the user with a customized listing of VOD programming selected according to user preference data (col. 3, lines 44-62).

Killian, U.S. Patent No. 6,163,316, discloses an electronic programming guide (EPG) that utilizes a viewer preference database to suggest programming deemed to be of interest to a viewer and generates a preferred listing of programming selected according to the viewer preference data to indicate the relative desirability of the available program listings (abstract; Figs. 5 and 6; see col. 16, line 7 – col. 17, line 6).

12. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

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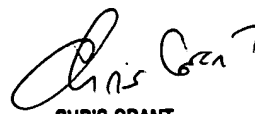
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Shelton whose telephone number is (703) 305-8714. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Shelton
Examiner
Art Unit 2611

BS


CHRIS GRANT
PRIMARY EXAMINER